

|| HAEBERLI
Application No.: 09/684,595
Page 5

PATENT

Applicants respectfully traverse the rejections and respectfully submit that all claims are in condition for allowance.

The §102 Rejection

Claims 1-9, 11-15, 17-19 and 21 under 35 U.S.C. 102(b) as being anticipated by Oles, which discloses a photographic camera synchronized to a video camera with a computer and viewing monitors that allows professional photography customers to visually determine the appropriate size of a portrait photograph and matching picture frame by displaying upon a viewer a perspective view of a video image of the photographic image and the matching picture frame within a simulated room image.

Applicants respectfully traverse the Section 102 rejection. Per MPEP Section 706.02, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Here, Oles fails to show the texture mapping element recited in the amended independent claims.

As discussed in page 6 of the instant specification, in one implementation of texture mapping, "When mapping the image onto the object, the color of the object at each pixel is modified by a corresponding color from the image. In this case, the picture image is the "texture" and the picture area is the "object" onto which the texture is mapped." FIG 4 of the instant specification shows another exemplary process 400 of texture mapping a picture image onto the picture area of a perspective frame image, in which the texture mapping includes multiplying a texture value by the original value of that pixel of the picture image. Claim 10 has been amended to cover this aspect of the present invention. Oles does not disclose modifying a texture value by the pixel values of the original image to map the image to an object..

Oles shows no such texture mapping. The mapping of Fig. 4 26 to Fig. 5 26 is a change in size of one picture to another picture.

Hence, Oles cannot anticipate claim 1 since it fails at least one claimed element. Since a Section 102 rejection requires EACH and EVERY element to be present, Oles cannot anticipate any of the independent claims and those dependent therefrom. Withdrawal of the Section 102 rejection on claims 1-9, 11-15, 17-19 and 21 is respectfully requested.

The Section 103 Rejections

HAEBERLI

Application No.: 09/684,595

PATENT

Page 6

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oles (6,047,130) in view of Kurashige (5,282,262). The Office Action noted that:

Oles discloses a system of generating a frame prototype image. It is noted that Oles does not explicitly disclose "mapping the picture image to the picture portion of the frame image includes mapping the picture image to the picture portion of the frame image using the illumination of the picture portion of the frame image", however, this is known in the art as taught by Kurashige. Kurashige discloses a method of transforming a two-dimensional image by illumination on a three-surface (Figure 4A-4B).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Kurashige into Oles because Oles discloses a system of generating a frame prototype image and Kurashige discloses mapping an image into an illuminated region in order to make the image more realistic.

Applicant respectfully traverses the Section 103(a) rejection. Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaack*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on all of the above requirements.

Here, the Office Action fails to establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Moreover, the prior art references fail to teach or suggest all the claim limitations. Here, neither Oles nor Kurashige shows at least the texture mapping element. Withdrawal of the Section 103 rejection on claim 10 is requested.

Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (5,870,771) in view of Oles. Again, the Office Action fails to establish that there is a reasonable

|| HAEBERLI
Application No.: 09/684,595
Page 7

PATENT

expectation of success for the modification. M.P.E.P. § 2142. Moreover, the prior art references fail to teach or suggest all the claim limitations. Here, neither Oles nor Oberg shows at least the texture mapping element. Withdrawal of the Section 103 rejection on claim 16 is requested.

In sum, since the references do not show at least the texture mapping in connection with the other elements in the independent claims, Applicants submit that the references cannot anticipate or render obvious any of the independent claims. The dependent claims are allowable since they depend from allowable independent claims.

CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested. If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



Bao Tran

Reg. 37,955